

REMARKS/ARGUMENTS

Standards for Patentability

1. "An applicant for a patent is entitled to the patent unless the application fails to meet the requirements established by law. It is the Commissioner's duty (acting through the examining officials) to determine that all requirements of the Patent Act are met. The burden is on the Commissioner to establish that the applicant is not entitled under the law to a patent In rejecting an application, factual determinations by the PTO must be based on a preponderance of the evidence, and legal conclusions must be correct." *In re Oetiker*, 977 F.2d 1443, 1449, 24 USPQ2d 1443, 1447, 24 USPQ2d at 1447 (Fed. Cir. 1992) (Judge Plager concurring).
2. "The precise language of 35 USC 102 that 'a person shall be entitled to a patent unless,' concerning novelty and unobviousness, clearly places a burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103." *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173 (CCPA 1967), cert. denied, 389 U.S. 1057, reh'g denied, 390 U.S. 1000 (1968).

Claim Rejections - 35 USC § 102

3. The Examiner rejected claims 1-3 and 5-9 under §102(b) as being anticipated by Blackburn (USPN 5,190,533). When Applicant refers to "Blackburn" herein, Applicant is only referring to the portion(s) of Blackburn actually cited by the Examiner.
4. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d. 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 828 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). MPEP § 2131.

5. Claim 1 contains the following element not shown in Blackburn: “..a strip of pressure sensitive adhesive transfer tape...said base side of said pressure sensitive adhesive *adhered* to said interior side of said strip of fabric *substantially along said first lengthwise edge...*” (emphasis added)

- a. The cited text/figure of Blackburn shows that the one end of the diaper has a tab 39. The “[t]ab 29 has pressure-sensitive adhesive surface 39a which adheres to the releasable surface 39. Tap 39 is pulled from releasable surface 39b and adhered to the front of diaper 20 (not shown) to enclose diaper 20 around the wearer.” (col. 6, ll. 49-53).
- b. Blackburn’s tab does not extend substantially along the first lengthwise edge. According to Applicant’s measurements and based on the scale of the drawings shown in Blackburn, Blackburn’s tab “extends” along less than 5% of the lengthwise edge. Five percent is not “substantially.”
- c. Blackburn’s tab instead attaches at a right angle near an end of the diaper. Such an orientation is thus generally perpendicular to the lengthwise edge rather than “extend[ing] substantially along” it.
- d. As such, Blackburn does not show all of the elements of claim 1 and therefore cannot anticipate claim 1 or any of the claims that depend therefrom (claims 2 and 3).

6. Claims 1 and 5 contains the following limitation not found in Blackburn, the elements cooperate to “... form a tubular configuration for enveloping the linear object, said tubular configuration having a first open end formed along said first widthwise edge and a second open end formed along said second widthwise edge.”

- a. Blackburn does not show such a tubular configuration. A closed diaper has a torso hole and two leg holes. Such a structure is not a tube.
- b. Blackburn does not disclose a first open end along said first widthwise edge and a second open end along said second widthwise edge. At best,

the widthwise edges of Blackburn come together to form two halves of a *single* open end (through which a baby's torso would extend).

- c. As such, Blackburn does not disclose all of the elements of claim 1, nor of claim 5, and therefore cannot anticipate claim 1, claim 5, or any of the claims that depend there-from (claims 2, 3, or 6-9).

7. Further, to constitute an anticipatory reference, the prior art must contain an enabling disclosure. *Chester v. Miller*, 906 F.2d at 1576 n.2, 15 U.S.P.Q.2d at 1336 n.2 (Fed. Cir. 1990); see also *Titanium Metals Corp. of America v. Banner*, 778 F.2d at 781, 227 U.S.P.Q. at 778 (Fed. Cir. 1985).

- a. A reference contains an enabling disclosure if a person of ordinary skill could have combined the description of the invention in the prior art reference with his own knowledge of the art to have placed himself, and thereby the public, in possession of the invention. *In re Donohue*, 766 F.2d 531, 533, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985); *In re Sheppard*, 339 F.2d 238, 242, 144 U.S.P.Q. 42, 45 (C.C.P.A. 1964).
- b. Blackburn does not contain an enabling disclosure because a person having ordinary skill in the art would have never combined Blackburn's disclosure of disposable diapers with his own knowledge of the art to place himself in possession with the present invention, namely a cord cover.
 - 1) A disposable diaper [Blackburn] couldn't even be used as a cord cover. For one thing, it isn't the right shape.
 - 2) Disposable diapers are not even in a related art. Thus, Blackburn's disclosure taken with knowledge of the art would never arrive at the present invention's cord cover.
- c. As such, Blackburn cannot anticipate the claims of the present invention.

Conclusion

If the Examiner feels it would advance the application to allowance or final rejection, the Examiner is invited to telephone the undersigned at the number given below. Reconsideration and allowance of the application as amended is respectfully requested.

DATED this 11th day of July 2006.

Very respectfully,



STEPHEN M. NIPPER
Reg. No. 46,260
(208) 345-1122



Examiner: Ahmad, Nasser
Serial # 10/634,204

CERTIFICATE OF MAILING

I HEREBY CERTIFY that this correspondence is being deposited with the United States Postal Service on the below date as first class mail in an envelope addressed to:

Mail Stop Amendment
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

DATE: July 11, 2006



Brandy L. Potter